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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,499	12/27/2001	Gary Wayne Reis	REIS 0101	8403

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EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 06/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,499

Applicant(s)

REIS, GARY WAYNE

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 8-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDonald (5,156,898) in view of Maude, Sr. (5,013,070).

McDonald discloses a rectangular sheet (10- as seen in figure 4) of foldable material having an upper side and a reverse side, the sheet having a plurality of substantially parallel primary folds (12) forming a series of panels foldably arranged one atop another; one or more secondary folds (14) in the sheet substantially perpendicular to the plurality of substantially parallel primary folds forming sub-panels which are foldably perpendicular to the primary folds; wherein one of the sub-panels forms a front cover (20) of the booklet and one of the sub-panels forms a rear cover (22) of the booklet.

McDonald discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claims. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia in the booklet since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it

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will not distinguish the invention from the prior art in terms of patentability. In re Gulack 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of booklet does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability. Further, Maude, Sr. discloses a golf score card (10) comprising a rectangular sheet (as seen in figure 1) containing graphic depictions of the holes of a golf course including "the general layout of the golf hole, from tee box to green, with the optional illustration of bunkers, hazards, and other obstacles." (see col. 1, lines 60-68). Maude, Sr. also discloses that "other suitable course information can be provided, such as shown at 22, to assist the player and scorer using the golf score card 10." (see col. 3, lines 10-12). As seen in figure 1, a matrix (12) is provided to keep score on a hole-by-hole basis for several players. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify McDonald's invention to include graphic depictions of a golf course on the foldable sheet, as taught by Maude, Sr., to provide a convenient, portable device that gives a golfer a quick reference of the golf course and enables scoring recordation.

Regarding claims 3 and 11, it would have been obvious to provide information on both the upper and reverse side of the sheet, since it has been held that mere

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duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claims 5 and 13, McDonald, as modified by Maude Sr., discloses that the substrate is markable (see Maude, Sr. col. 1, lines 54-59).

Regarding claims 6 and 14, it would have been advantageous and obvious to one having ordinary skill in the art to provide the booklet dimensioned to be insertable within clothing pockets, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Further, making the booklet pocket-sized enables the golfer to easily carry the booklet along as he/she plays the game.

Regarding claims 8 and 16, the primary folds are substantially evenly spaced (as seen in McDonald, figure 4).

Regarding claims 9-12, see the above rejections to claim 1.

3. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDonald in view of Maude, Sr. and further in view of Kelly (4,487,431).

McDonald, as modified by Maude, Sr., discloses the claimed invention except for a sheet of paper being inserted inside the folded form of the booklet, the insert containing promotional materials and information and instructions on the use of the booklet.

Kelly discloses a folded booklet (10) having insert pages (12). The insert is printed with promotional information, which could include use instructions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia on the insert pages, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of insert does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify McDonald's invention to include an insert, as taught by Kelly, to provide the booklet with removable promotional information to portray a particular message to the user.

Response to Arguments

4. Applicant's arguments filed April 1, 2003 have been fully considered but they are not persuasive.

Applicant argues that McDonald as modified by Maude, Sr., fails to disclose the invention as set forth in the embodiments. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., folding the inner surfaces of the lower panels inwardly toward the central panels, after, and only after, the lower panels are substantially inwardly folded, the upper panels are folded inwardly) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that the cited prior art fail to disclose retaining an additional insert. In light of the newly cited reference (Kelly), this argument is rendered moot.

Applicant argues that the claimed printed matter is functionally related to the scorecard. The examiner disagrees. In the present invention, the claimed scorecard and booklet visually assists a player in playing a round of golf at a golf course. The claimed device merely comprise printed matter which is supported by a substrate where the printed matter does not convey any meaningful information in regard to the substrate and does not require any particular substrate to effectively convey the information. Thus, there is no meaningful functional relationship between the indicia and the substrate. The examiner asserts that the folded sheet of McDonald, as modified by the golf score card of Maude, Sr. is the same structure claimed by applicant and the sole difference is in the content of the printed material. Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason

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to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.


For the reasons as set forth above, the rejections are maintained.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


MONICA CARTER
PATENT EXAMINER

June 9, 2003